

### **REMARKS**

Applicants submit these remarks as part of the Request for Continued Examination and in response to the Final Office Action, dated June 30, 2006.

Currently, claims 1-37 are pending in the application with claims 1, 10, 19, 24 and 25 being independent. Claims 27-37 are new. The support for these claims is found, *inter alia*, in the Applicants' specification on page 5, lines 9-22, and page 6, line 8 to page 7, line 21. Claim 10 is amended to correct an informality.

#### **35 U.S.C. 102(e)**

In the Final Office Action, the Examiner maintained the rejections of claims 1-9, 19-23, and 25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,493,110 to Roberts (hereinafter, "Roberts"). These rejections are respectfully traversed.

In the Final Office Action, the Examiner states that "Applicant's arguments filed April 14, 2006 have been fully considered by they are not persuasive." (Final Office Action, page 6). However, the Examiner continues to ignore Applicants' argument that Roberts is not a proper 102(e) reference.

In the January 25, 2006 Office Action, the Examiner issued a 35 U.S.C. 102(e) rejection of claims 1-9, 19-23, and 25, which had substantially the same scope, as a 35 U.S.C. 102(e) rejection in the July 7, 2005 Office Action. In the Final Office Action, the Examiner did not address the arguments relating to the above rejections. Under MPEP § 707.07(f), the Examiner is obligated to answer all material traversed:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Since, the Examiner did not address Applicants' traversal of the 35 U.S.C. 102(e) rejection in the July 7, 2005 Office Action, the January 25, 2006 or the Final Office Action, Applicants hereby restate and reassert the arguments, filed in response to the July 7, 2005 Office Action, in response to the 35 U.S.C. 102(e) rejection of claims 1-9, 19-23, and 25 over Roberts in the Final Office Action. Thus, the 35 U.S.C. 102(e) rejections over Roberts in the July 7, 2005 Office Action, the January 25, 2006 Office Action, and the Final Office Action are traversed.

In the January 25, 2006 Office Action, the Examiner recited a pre-AIPA version of 35 U.S.C. 102(e) as a basis for her rejection of claims as anticipated by Roberts. As Applicants stated in response to the July 7, 2005 Office Action, the pre-AIPA version of 35 U.S.C. 102(e) is relevant only when the prior art reference that the Examiner is relying upon to reject Applicant's claims is based on a published international application filed before November 29, 2000 that designated the United States. MPEP §§ 706.02(a), 2136-2136.05. Otherwise, the revised version of 35 U.S.C. 102(e) applies. In the Final Office Action, the Examiner recited a different version of the 35 U.S.C. 102(e). Despite such recitation, Roberts still cannot be used to reject claims of the present application under 35 U.S.C. 102(e).

The recited version of 35 U.S.C. 102(e) states as follows:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the

United States before the invention by the application for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Roberts was filed on April 5, 2000 and does not claim priority to any other application.

Roberts was **not** published until its issue date. Even if it was published, its publication date would have been subsequent to the filing date of the present application (i.e., December 15, 2000). Hence, the Examiner cannot use Roberts to reject claims in the present application under 35 U.S.C. 102(e)(1).

With regard to 35 U.S.C. 102(e)(2), Roberts does not qualify as a “patent granted on an application for patent by another filed in the United States before the invention by the application for patent” nor does it not claim the benefit of an international application, thus, the Examiner cannot use Roberts to reject claims of the present application under 35 U.S.C. 102(e)(2). Thus, Roberts is **not** a proper reference. As such, the Applicants respectfully request that the Examiner withdraw the 35 U.S.C. 102(e) rejection based on Roberts.

In addition to the fact that Roberts is **not** a proper 35 U.S.C. 102(e) reference, Roberts does not anticipate the claims of the present Application, for the reasons discussed below.

Claim 1 recites a method of printing a receipt which includes an image, comprising downloading transaction information; retrieving an image associated with the transaction information; converting the image into a pixels matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation.

Roberts discloses a system and a method for bar code rendering and recognition. Specifically, Roberts describes formatting data into a readable bar code format. The bar code

format includes transaction data relating to a coupon, such as redemption amount, expiration or term of offer, identity of coupon holder, etc. (Roberts, Col. 7, lines 1-15). Roberts generates coupons with a coupon data management program that uses a computer to request coupon data from the centrally located repository, which stores the coupon data and transmits it for printing. (Roberts, Col. 8, lines 43-48). Roberts' bar code is encoded with user specific information, such as user name and/or other unique identification criteria such as a social security number or online services address (Roberts, Col. 11, lines 54-57). Also, Roberts' coupons are based on demographic data and historic buying profiles stored in the demographic data file. (Roberts, Col. 12, lines 44-47).

Roberts fails to disclose downloading transaction information, where the transaction information relates to a consumer transaction and retrieving an image associated with the transaction information, as recited in claim 1. Instead, Roberts requests certain coupons based on the unique user identification information, which is unrelated to the downloaded transaction information recited in claim 1. In fact, Roberts selects coupons from coupon packages 40. (Roberts, Col. 11, lines 13-25). The coupon packages are generated based on user specific data relating to coupons, such as, coupons selected data, coupons deleted data, coupons printed data as well as user demographics (e.g., user's name, social security number, etc. (Roberts, Col. 11, lines 54-57)). Roberts also performs a marketing analysis based on this information to generate coupon packages. (Roberts, Col. 11, lines 13-25; Col. 12, lines 8-11 and lines 42-49). This information does not relate to a consumer transaction, rather it relates to user demographics and purchasing profiles, contrary to the Examiner's suggestion and recitation of claim 1. The disclosure of Roberts is different from the recitation of claim 1, where a receipt's image is printed based on transaction information relating to a consumer transaction, rather than pre-

stored user identification information. Additionally, Roberts allows users to access an online database in order to obtain coupon data related to an advertised product (Roberts, Col. 17, lines 52-55). Hence, no transaction information relating to a consumer transaction is being downloaded, contrary to the recitation of claim 1.

To print coupons, using the system disclosed in Roberts, the system requests coupon data from one of the coupon packages and employs its document generating module to print coupons with bar codes. (Roberts, Col. 7, lines 17-27). Thus, Roberts does not retrieve any images associated with the transaction information, contrary to the recitation of claim 1.

Roberts also does not disclose selectively printing pixels corresponding to the pixel matrix representation. Roberts discloses bar code image parameters and how the bar code is defined by its width, stretching factor, misalignment factor, print area width, and aliased to smooth out the edges. (Roberts, Col. 20, lines 10-59). However, Roberts does not disclose that the scan lines are printed by selectively printing pixels corresponding to the pixel matrix representation.

For the foregoing reasons, Roberts does not disclose every element of claim 1 and claim 1 is not anticipated by Roberts and should be allowed.

Claims 19 and 25 are not anticipated by Roberts for at least the reasons stated above with respect to claim 1. As such, the rejections of claims 19 and 25 are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejection of claims 19 and 25.

Claims 2-9 and 20-23 depend on independent claims 1 and 19 respectively. As such, claims 2-9 and 20-23 are not anticipated by Roberts for at least the reasons stated above with respect to claim 1. Thus, these rejections are respectfully traversed. The Examiner is requested to

reconsider and withdraw his rejections of claims 2-9 and 20-23. New claims 27-37 are not anticipated for at least the reasons stated above with regard to claim 1.

35 U.S.C. 103(a)

In the Final Office Action, the Examiner maintained rejections of claims 10-18 and 26 under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of U.S. Patent No. 6,334,109 to Kanevsky et al. (hereinafter, "Kanevsky"). This rejection is respectfully traversed.

Claim 10 recites, *inter alia*, a method of printing a coupon which includes an image, comprising monitoring transaction information; retrieving an image associate with the transaction information; converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation.

According to the Examiner, Roberts discloses all of the elements of claim 10 except that it "does not teach monitoring transaction information that relates to a consumer transaction, comparing the information to a database." However, the Examiner asserts that "Kanevsky teaches monitoring user transaction and comparing the transaction to an advertisement database and downloading advertisement information from the database responsive to the match and printing the downloaded advertisement on a receipt or coupon." (See, Final Office Action, Page 4).

As stated above, Roberts discloses a system and a method for bar code rendering and recognition. (See, Roberts, Abstract). Roberts includes a document generating module that creates a desired document, such as a coupon, by applying predefined document formatting rules to the received document. (Roberts, Col. 7, lines 17-20). Roberts checks the resolution of printers on which the document will be printed and optimizes the scale of the bar code so that the bar

code lines and pixels perfectly align to avoid blurry or grainy lines. (Roberts, Col. 7, lines 32-36). Roberts scales the document based on the resolution of the printer and then delivers the document to the attached printer for printing. (Roberts, Col. 19, line 1-12 and Col. 19, line 61 to Col. 20, line 31).

However, in addition to failing to disclose monitoring transaction information as admitted by the Examiner in the Final Office Action, Roberts does not disclose, teach or suggest, *inter alia*, retrieving an image associated with the monitored transaction information, converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation. Instead, Roberts discloses formatting rules to scale a particular document in accordance with specific printer requirements. (Roberts, Col. 7, lines 17-40). Further, Roberts' scaling module detects resolution of a particular printer and scales the document appropriately by using "the greatest whole number multiple of the number of required pixels to insure that the pixel data is aligned with the available pixel columns and center[ing] the image [(i.e., the bar code)] in the total available pixels." (Roberts, Col. 20, lines 21-25). However, Roberts does not disclose a pixel matrix representation into which the retrieved image is converted, as recited in claim 10. Finally, Roberts does not disclose printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10. In contrast, Roberts scales the image so that the scaled bar code image pixel width aligns perfectly with the print area pixel width to effectively eliminate inaccurate renderings and the resulting inaccurate deciphering of the bar code information. (Roberts, Col. 20, lines 10-15). Roberts does not print bar codes according to the pixel matrix representation. Instead, it simply stretches/scales the bar code images to fit within a designated print area. Hence, Roberts does not disclose, teach or suggest all elements of claim 10.

In the Final Office Action, the Examiner stated that Kanevsky teaches monitoring transaction information. However, Kanevsky fails to cure the deficiencies presented by Roberts. Kanevsky does not disclose, teach or suggest, *inter alia*, retrieving an image associated with the transaction information, converting the image into a pixel matrix representation, and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10. Hence, neither Roberts nor Kanevsky disclose, teach or suggest all elements of claim 10 and claim 10 should be allowed.

*Improper to Combine References*

There is no motivation or suggestion to combine Roberts and Kanevsky to produce the claimed invention. Roberts discloses a system that detects printer resolution requirements and scales an image (i.e., bar code) to fit within an area having a specific number of pixels. In contrast, Kanevsky discloses a system for printing advertisements. The technology disclosed in Roberts belongs to a class of “facsimile and static presentation processing” with a subclass of “size, resolution, or scale control” (Class 358/1.2). In contrast, the technology disclosed in Kanevsky belongs to a class of “data processing: financial, business practice, management, or cost/price determination” with a subclass of “distribution or redemption of coupon, or incentive or promotion program” (Class 705/14). Contrary to the Examiner’s suggestion (Final Office Action, page 8), Roberts technology class relates to mechanical characteristics of a printer (size, resolution, etc.). In contrast, Kanevsky relates to financial aspects of distributing coupons. The two technologies significantly differ from each other and provide no basis as to why they would be combined. Hence, it is improper to combine Roberts and Kanevsky without some disclosed motivation other than the present application. See, MPEP 2143.01:



“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.).

Even if one were to combine Roberts and Kanevsky, the present invention is not realized. The improper combination of Roberts and Kanevsky still fails to disclose, teach or suggest, *inter alia*, retrieving an image associated with transaction information; converting the image into a pixel matrix representation; and printing at least one scan line by selectively printing pixels corresponding to the pixel matrix representation, as recited in claim 10.

Thus, even the improper combination of Roberts and Kanevsky does not render claim 10 obvious. As such, this rejection is respectfully traversed. The Examiner is requested to reconsider and withdraw her rejection of claim 10.

Claims 11-18 depend from independent claim 10. As such, claims 11-18 are patentable over the combination of Roberts and Kanevsky for at least the reasons stated above with respect to claim 10. Thus, the rejections of claims 11-18 are respectfully traversed. The Examiner is requested to reconsider and withdraw her rejections of claims 11-18.

Claim 26 depends from independent claim 25. As such, claim 26 is patentable over the Roberts for at least the reasons stated above with respect to claim 25 (See, discussion of Applicants’ traversal of 35 U.S.C. 102(e) rejection over Roberts presented above). Further, Kanevsky does not cure the deficiencies of Roberts as stated above with respect to claim 10. Hence, the rejection of claim 26 is respectfully traversed. The Examiner is requested to reconsider and withdraw her rejection of claim 26.

In the Final Office Action, the Examiner rejected claim 24 under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Roberts. Claim 24 is patentable over the combination of Kanevsky and Roberts for at least the reasons stated above with respect to claims 1 and 10. Thus, the rejection of claim 24 is respectfully traversed. The Examiner is requested to reconsider and withdraw her rejection of claim 24.

Further, new claims 27-37 are patentable over various combinations Roberts and Kanevsky for at least the reasons stated above with regard to claims 10-18, 24 and 26.

**CONCLUSION**

No new matter has been added.

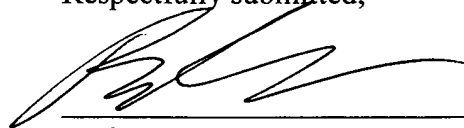
The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Applicants believe that no additional fees are due with the filing of this Amendment. However, if any additional fees are required or if any funds are due, the USPTO is authorized to charge or credit Deposit Account Number: **50-0311**, Customer Number: **35437**, Reference Number: **27996-030**.

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Respectfully submitted,



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